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EXAMINER

NGUYEN, KIMBERLY T

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1774

DATE MAILED: 06/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/777,040

Applicant(s)

SIGEL ET AL.

Examiner

Kimberly T. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 23-37 and 46-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 38-45 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-54 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-22 and 38-45, drawn to a surface covering or surface covering component, classified in class 428, subclass 195.
- II. Claims 23-37 and 46-54, drawn to a method for making a surface covering or surface covering component, classified in class 427, subclass 44.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as adhering the compositions to the coated substrates.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with David S. Bradin on May 6, 2002 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-22 and 38-45. Affirmation of this election must be made by applicant in replying to this Office action. Claims 23-37 and 46-54 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Objections

Claim 43 is objected to because of the following informalities: the phrase "top of bottom surface" should be amended to "top or bottom surface". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-22 and 38-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "substantially" in claims 1 and 38 is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

In claim 6, the phrase "localized adjacent one surface of the topcoat" is unclear.

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Claim 12 recites the limitation "a *second* thermal curing agent" in line 2. There is insufficient antecedent basis for this limitation in the claim.

In claims 15, 19, 20, and 43, the phrase "are in/not in register with" is unclear. For purposes of examination, the phrase "in register with" will be interpreted to mean "in contact with."

In claim 38, the phrase "is substantially in register with at least a portion of the design" is unclear.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

¹⁶⁻²²
Claims 1-15, ~~19~~, 38-39, and 43-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Schmidle et al., U.S. Pat. No. 4,491,616.

Schmidle shows a decorative surface covering comprising a base layer (film) and a wear layer directly overlying and adjacent to the base layer comprising a radiation curable composition with regions of low and high gloss levels wherein the regions comprise a photoinitiator (photoinitiator and cure altering agent) and a uniform layer of curable monomeric material (claim 1). Schmidle shows that the resinous polymer composition includes various accelerators (cure altering agent) (column 4, lines 64-68). Schmidle shows that the wear layer comprises more than one initiator (first and second thermal initiators) (column 6, lines 3-7) and fillers such as clay and limestone (flatting agents) (column 5, lines 1-8). Schmidle shows that a

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UV-curable composition of methacrylated polyester (UV-curable component) in the wear layer (column 11 to column 12). Schmidle further shows that the photoinitiator forms a discontinuous pattern in regions wherein the pattern is between the substrate and the wear layer and is in contact with the UV-curable composition (Abstract). Schmidle shows that the wear and pattern layer comprising the UV-curable composition also comprises various heat stabilizers (thermal curing agent) (column 4, line 64 to column 6, line 16). Schmidle shows that the pattern includes a pigment (column 3, lines 63-67). Schmidle shows a "pigmented ink printing layer" applied to the top of the base layer (claim 4). *+ gloss controlling agent*
+ B in register with base layer w/ diff. thicknesses.

Claims 9 and 16-22 are rejected because they are product-by-process claims.

Additionally, the phrases "wherein the different gloss levels are achieved by curing...using a first polymerization condition...in the region" (in claim 9), "the second polymerization condition takes place after the first polymerization condition" (in claim 16), "the first polymerization condition includes exposure to UV irradiation and/or heat" (in claim 17), "the second polymerization condition includes exposure to EB or UV irradiation" (in claim 18), "composition is polymerized in register with the photoinitiator in the selected regions by UV irradiation" (in claim 19), "the UV-curable composition...is subsequently polymerized by electron beam irradiation" (in claim 20), "the UV-curable composition is polymerized by UV radiation" (in claim 21), and "the UV-curable composition is subsequently further polymerized...by longer exposure times" (in claim 22) introduce process limitations to the product claims. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior

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art, the claims are unpatentable even though the prior art was made by a different process.

MPEP 2113. Further, process limitations are given no patentable weight in product claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21 and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidle et al., U.S. Pat. No. 4,491,616 in further in view of Sigel et al., U.S. Pat. No. 6,333,076 B1.

Schmidle is relied upon as above for claims 9 and 38. Though Schmidle shows that the base layer comprises resinous polymer compositions, Schmidle does not specifically show that the base layer is transparent or translucent as in instant claim 41. However, Schmidle shows that several types of backing sheets are equally suitable and are utilizable in special situations, such as transparent backing sheets (column 4, lines 17-43).

Schmidle does not show that the UV-curable composition includes a photoinitiator as in instant claim 21. Schmidle does not show that the wear layer is transparent or translucent as in instant claim 42. Sigel shows a gloss surface coated wearlayer comprising a transparent wear layer (column 1, lines 24-27) and photoinitiators in a UV-curable resin layer (column 4, lines 8-31). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a photoinitiator in a UV-curable composition in a transparent wear layer since it is known, as shown by Sigel, that a photoinitiator is effectively used with UV-curable

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compositions to aid in the formation of radicals upon UV radiation and that it is obvious to use a transparent wear layer for aesthetic purposes in making decorative floor coverings.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly T. Nguyen whose telephone number is (703) 308-8176. The examiner can normally be reached on Monday to Friday, except on every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Kimberly T. Nguyen
Examiner
June 3, 2002

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
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